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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,849	02/26/2002	Neal Zahn	WIN825/01830	6832
24118	7590	02/09/2004	EXAMINER	
HEAD, JOHNSON & KACHIGIAN 228 W 17TH PLACE TULSA, OK 74119			MARX, IRENE	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

10/082,849

Applicant(s)

ZAHN ET AL.

Examin r

Irene Marx

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

The application should be reviewed for errors and conformity with domestic practice.

The amendment filed 11/28/03 is acknowledged. Claims 1-10 are being considered on the merits. Claims 11-16 are withdrawn from further consideration as directed to a non-elected invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite in the recitation of "soluble humatic compounds". The meaning of humatic cannot be readily determined.

Claim 1 appears redundant in the recitation of "whole-grain barley grain".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Richards *et al.*

The claims are directed to a fermentation composition comprising an organic matrix comprising one or more of barley straw, rye straw, wheat straw, ground barley or whole-grain

barley grain, and saprophytic bacteria, such as *Bacillus subtilis*, hydrolytic enzymes and “humatic” compounds.

Richards *et al.* disclose a fermentation composition comprising an organic matrix of wheat straw, saprophytic bacteria such as *Bacillus subtilis*, hydrolytic enzymes and “humatic” compounds. See, e.g., page 2, col. 2. The bacteria present produce hydrolytic enzymes and “humatic” compounds *in situ*.

Richards *et al.* disclose a fermentation composition comprising an organic matrix of wheat straw, saprophytic bacteria such as *Bacillus subtilis*,

Claims 1-6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ely *et al.* (U.S. Patent No. 3,151,983).

The claims are directed to a fermentation composition comprising an organic matrix comprising one or more of barley straw, rye straw, wheat straw, ground barley or whole-grain barley grain, and saprophytic bacteria, such as *Bacillus subtilis*, hydrolytic enzymes and “humatic” compounds.

Ely *et al.* disclose a fermentation composition comprising an organic matrix of ground barley, saprophytic bacteria such as *Bacillus subtilis*, hydrolytic enzymes and “humatic” compounds. See, e.g., col. 3, lines 32-51 and bridging paragraph between col. 5 and 6, et seq.. This composition also comprises wheat bran. This material constitutes a fermentation composition, since it can reasonably be presumed that fermentation continues at least to some extent in the composition disclosed at col. 6, since the bacteria are viable. Drying without inactivation is disclosed at col. 5, lines 14-23.

It is noted that Ely *et al.* does not teach that the composition can be used for treatment of aquatic environments, however, the intended use of the composition does not distinguish the composition since such undisclosed use is inherent in the Ely *et al.* composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus, the intended use is not limiting. “The claiming of a new use . . . which is inherently present in the prior art does not necessarily make the claim patentable.” *In re Best*, 195 USPQ 430, 433 (CCPA 1977). When applicant claims a “composition in terms of function . . . and the composition of the prior art is the same as that of the claim but the function is not

explicitly disclosed by the reference, the Examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection” (MPEP 2112).

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ely *et al.* taken with Richards *et al.* and Jeffreys.

The claims are directed to a fermentation composition comprising an organic matrix comprising one or more of barley straw, rye straw, wheat straw, ground barley or whole-grain barley grain, and saprophytic bacteria, such as *Bacillus subtilis*, hydrolytic enzymes and “humatic” compounds.

Ely *et al.* disclose a fermentation composition comprising an organic matrix of ground barley, saprophytic bacteria such as *Bacillus subtilis*, hydrolytic enzymes and “humatic” compounds. See, e.g., col. 3, lines 32-51 and bridging paragraph between col. 5 and 6, et seq.. The composition also comprises wheat bran. This material constitutes a fermentation composition, since it can reasonably be presumed that fermentation continues at least to some extent in the composition disclosed at col. 6, since the bacteria are viable. Drying without inactivation is disclosed at col. 5, lines 12-23.

It is noted that Ely *et al.* does not teach that the composition can be used for treatment of aquatic environments, however, the material disclosed can reasonably be presumed to be suitable for this purpose, since it contains the same or substantially the same ingredients. Moreover, the intended use of the composition does not distinguish the composition since the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus, the intended use is not limiting. “The claiming of a new use . . . which is inherently present in the prior art does not necessarily make the claim patentable.” *In re Best*, 195 USPQ 430, 433 (CCPA 1977). When applicant claims a “composition in terms of function . . . and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the Examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection” (MPEP 2112).

Richards *et al.* U.S. Patent No. 1,471,979 disclose a similar composition comprising wheat straw which appears to be dried at least to some extent.

In addition, Jeffreys U.S. Patent No. 2,766,1760 teaches a similar composition comprising an organic matrix of a similar constitution comprising saprophytic bacteria, hydrolytic enzymes and "humatic" compounds, which is dried and which appears to be granular at least to some extent. (See, e.g., Examples IV and IX). This material is disclosed as suitable for the treatment of aquatic environments, such as sewage. The saprophytic bacteria would reasonably be expected to include *Bacillus* (See, e.g., col. 4, lines 63-71).

It would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the composition of Ely *et al.* by providing a dried and granulated composition which is suitable for the treatment of aquatic environments for the expected benefits of providing bacteria to the aquatic environment suitable for the degradation of undesirable contaminants in the water.

Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is 571-272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.



Irene Marx  
Primary Examiner  
Art Unit 1651